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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,789	07/28/2003	James Jannard	NOCODE2.005C1	5220
20995	7590	09/22/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			DANG, HUNG XUAN	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2873	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/628,789

Applicant(s)

JANNARD ET AL.

Examiner

Hung X. Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 15-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-7 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. The amendment filed on 6/30/06 has been entered.

### **Information Disclosure Statement**

2. The Information Disclosure Statement filed on 6/30/06 has been considered.

### **Claims Rejection Under 35 USC – 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Vaudrey et al** (6,311,155).

Swab et al discloses eyewear with exchangeable temples housing a transceiver forming AD hoc networks with other device which comprises a frame 24 for holding the lenses, a pair of temples 19, 20 extending rearward from the frame, first and second speakers 60 and 62 mounted to the first and second temples respectively, so as to be translatable in a forward to rearward direction generally parallel to the temples over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provide an effective range of coverage of about 1 1/4 inches, an audio file storage and playback device disposed within the first ear stem,

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52 a power storage device disposed in the second temple at least one button 50 disposed on the first temple.

Swab et al does not teach that a compressed audio file storage and play back device disposed in the temple.

Vaudrey et al however, discloses a MP3 play back device in eyeglasses frame (see column 1-20.)

Because Swab et al and Vaudrey et al are both from the same field of endeavor, the purpose of listening the music as disclosed by Vaudrey et al would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al, a MP3 play back device in eyeglasses frame, such as disclosed by Vaudrey et al for the purpose of listemnig the music.

#### **Claims Rejection Under 35 USC - 103**

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) and **Vaudrey et al** (6,311,155) as applied to claims 8 and 11-14 above, and further in view of **Vogt et al** (5,606,743).

Swab et al and Vaudrey et al disclose the claimed invention as stated above with the exception of a volume control.

Vogt et al, however, discloses radio eyewear comprises a volume turning control are included with the receiver compartments 6 and 8 (see column 5, lines 20-22.)

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Because Swab et al, Vaudrey et al and Vogt et al are all from the same field of endeavor, the purpose of controlling the volume of the speaker as disclosed by Vogt et al would have been recognized as an art pertinent art of Swab et al and Vaudrey et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al and Vaudrey et al, with a volume control, such as disclosed by Vogt et al for the purpose of controlling the volume of the speaker.

#### Claims Allowance

5. Claims 1-7 and 30-36 are allowed.
6. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

9/06



HUNG DANG

PRIMARY EXAMINER

TC 2800